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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/740,372	12/19/2000	Samuel N. Zellner	00137	4936
7590 04/15/2004				
Jonathan C. Parks, Esq. Kirkpatrick & Lockhart LLP Henry W. Oliver Bldg. 535 Smithfield Street Pittsburgh, PA 15222-2312			EXAMINER MILLER, BRANDON J	
			ART UNIT 2683	PAPER NUMBER 12
DATE MAILED: 04/15/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/740,372

Applicant(s)

ZELLNER ET AL.

Examiner

Brandon J Miller

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 14.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Response

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Walsh.

Regarding claim 1 Walsh teaches a method of providing an identity-blocking service (see col. 3, lines 5-7). Walsh teaches obtaining an identity of a user operating a wireless communication device (see col. 4, lines 54-55). Walsh teaches obtaining first information about a first location of the user (see col. 8, lines 55-59). Walsh teaches transferring the first information about the first location of the user to a third party without disclosing the identity of the user to the third party (see col. 8, lines 60-64).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-12, 14-23 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walsh in view of Owensby.

Regarding claim 2 Walsh teaches a device as recited in claim 1 except for charging a fee to a user for blocking the identity of a user from being disclosed to a third party. Walsh does teach blocking the identity of a user from being disclosed to a third party (see col. 8, lines 60-64). Owensby does teach charging a fee for a provided service (see col. 21, lines 58-60). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the invention adapt to include charging a fee to a user for blocking the identity of a user from being disclosed to a third party because this would allow for subscriber information used in WEB based distribution of advertisements to be available at a charge.

Regarding claim 3 Owensby teaches a third party that is an advertiser desirous of sending an advertisement to a wireless communication device (see abstract and col. 11, lines 20-25).

Regarding claim 4 Walsh teaches storing information about the identity of a user (see col. 4, lines 54-55). Owensby teaches a variety of user specific information about the identity of a user and storing the information about the identity of the user (see col.15, lines 47-59 and FIG. 2).

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Regarding claim 5 Owensby teaches requesting a user to provide a variety of information about the identity of the user that is performed when the user signs up for a communication service that allows the user to operate the wireless communication device (see col. 15, lines 47-52).

Regarding claim 6 Walsh teaches a method of requesting an identity-blocking service (see col. 2, lines 60-67 and col. 3, lines 5-7). Owensby teaches requesting a user to provide a variety of information about the identity of the user that is performed when the user signs up for a communication service (see col. 15, lines 47-52).

Regarding claim 7 Owensby teaches storing information that includes a maintaining a database to store information therein (see col. 15, lines 47-59 and FIG. 2).

Regarding claim 8 Owensby teaches obtaining information about the location of a user that includes monitoring one or more signals transmitted by the wireless communication device operated by the user; and determining the location of the user based on an analysis of one or more signals (see col. 12, lines 26-37, 40-43 & 50-60).

Regarding claim 9 Walsh teaches receiving information about the location of a user supplied by a wireless communication device (see col. 8, lines 55-59).

Regarding claim 10 Walsh teaches transferring the information about the location of a user to a third party without disclosing the identity of the user to the third party (see col. 8, lines 55-59). Owensby teaches obtaining second information about a second location of a user when a user moves a pre-determined distance from the first location (see col. 12, lines 26-37, 40-43 & 50-60).

Regarding claim 11 Owensby teaches monitoring the movement of a user operating a wireless communication device (see col. 12, lines 30-37). Owensby teaches sending an indication of the location when the user is found to be in a substantially continuous motion (see col. 12, lines 52-63).

Regarding claim 12 Walsh teaches a device as recited in claim 1 except for charging a fee to a third party for information about the first location of a user. Walsh does teach information about the location of a user (see col. 8, lines 54-64). Owensby does teach charging a fee for a provided service (see col. 21, lines 58-60). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the invention adapt to include charging a fee to a user for blocking the identity of a user from being disclosed to a third party because this would allow for subscriber information used in WEB based distribution of advertisements to be available at a charge.

Regarding claim 14 Walsh teaches a device as recited in claim 1 except for allowing a user to unblock disclosure of the identity of a user to a third party. Walsh does teach allowing a user to set rules of communication that will prohibit at least one of an identity and a location of a user to a third party (see abstract and col. 2, lines 61-67). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the invention adapt to include allowing a user to unblock disclosure of the identity of a user to a third party because this would allow for direct communication between a WEB based advertisement distributor and a wireless subscriber.

Regarding claim 15 Stewart teaches a device as recited in claim 1 except for allowing a user to unblock disclosure of the identity of a user over the Internet. Walsh does teach allowing

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a user to set rules of communication that will prohibit at least one of an identity and a location of a user to a third party (see abstract and col. 2, lines 61-67). Owensby does teach a wireless communications services that include the Internet (see col. 11, lines 61-65). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the invention adapt to include allowing a user to unblock disclosure of the identity of a user to a third party because this would allow for direct communication between a WEB based advertisement distributor and a wireless subscriber.

Regarding claim 16 Walsh teaches a method of providing information about a location of a user operating a wireless communication device (see col. 8, lines 52-59). Walsh teaches obtaining an identity of a user operating a wireless communication device (see col. 4, lines 54-55). Walsh teaches identifying the location of the user of the wireless communication device (see col. 5, lines 39-42 and col. 8, lines 55-59). Walsh teaches transferring information about the location of the user that excludes disclosure of the identity of the user (see col. 8, lines 60-64). Walsh does not specifically teach a subscriber desirous of sending an advertisement to a wireless communication device. Owensby teaches a third party that is an advertiser desirous of sending an advertisement to a wireless communication device (see abstract and col. 11, lines 20-25). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the device adapt to specifically include a subscriber desirous of sending an advertisement to a wireless communication device because this would allow for secure WEB based distribution of advertisements to wireless communication subscribers.

Regarding claim 17 Walsh teaches a device as recited in claim 16 except for charging a fee to a user for preventing the disclosure of the identity of the user to the subscriber. Walsh

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does teach preventing the disclosure of the identity of the user to a subscriber (see col. 8, lines 60-64). Owensby does teach charging a fee for a provided service (see col. 21, lines 58-60). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the invention adapt to include charging a fee to a user for blocking the identity of a user from being disclosed to a third party because this would allow for subscriber information used in WEB based distribution of advertisements to be available at a charge.

Regarding claim 18 Walsh and Owensby teach a device as recited in claim 4 and is rejected given the same reasoning as above.

Regarding claim 19 Walsh and Owensby teach a device as recited in claim 5 and is rejected given the same reasoning as above.

Regarding claim 20 Walsh and Owensby teach a device as recited in claim 8 and is rejected given the same reasoning as above.

Regarding claim 21 Walsh and Owensby teach a device as recited in claim 12 and is rejected given the same reasoning as above.

Regarding claim 22 Owensby teaches monitoring the movement of a user operating a wireless communication device (see col. 12, lines 30-37). Owensby teaches informing a subscriber at pre-determined intervals about changes in location of a user (see col. 12, lines 26-37, 40-60).

Regarding claim 23 Stewart and Owensby teaches a device as recited in claim 16 except informing a subscriber over the Internet. Walsh does informing a subscriber about location information (see col. 8, lines 55-59). Owensby does teach a wireless communications services that include the Internet (see col. 11, lines 61-65). It would have been obvious to one of ordinary

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skill in the art at the time the invention was made to make the invention adapt to include allowing a user to informing a subscriber over the Internet because this would allow for direct communication between a WEB based advertisement distributor and a wireless subscriber.

Regarding claim 25 Walsh and Owensby teach a device as recited in claim 15 and is rejected given the same reasoning as above.

Claims 13 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walsh in view of Owensby and Hidary.

Regarding claim 13 Walsh and Owensby teach a device as recited in claim 1 except for disclosing the identity of a user to an emergency service provider when a user request emergency help. Hidary teaches providing an emergency channel to an emergency service provider when a user requests emergency help (see col. 2, lines 57-62). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the invention adapt to include disclosing the identity of a user to an emergency service provider when a user request emergency help because this would allow for WEB based distribution of advertisements to be bypassed during an emergency situation.

Regarding claim 24 Walsh and Owensby teach a device as recited in claim 16 except for disclosing the identity of a user to an emergency service provider when a user request emergency help. Hidary teaches providing an emergency channel to an emergency service provider when a user requests emergency help (see col. 2, lines 57-62). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the invention adapt to include disclosing the identity of a user to an emergency service provider when a user request emergency

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help because this would allow for WEB based distribution of advertisements to be bypassed during an emergency situation.

Response to Arguments

Applicant's arguments with respect to claims 1-25 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Tajima et al U.S. Patent 6,101,381 discloses a telecommunications system, radio base station thereof, and portable telecommunication terminal thereof.

Rouhollahzadeh et al. U.S. Patent 6,208,866 discloses a system and method for location-based marketing to mobile stations with a cellular network.

Mankoff U.S. Patent 6,385,591 discloses a method and system for electronic organization of coupons.

Rochkind U.S. Patent 5,875,401 discloses a method and apparatus for initiating wireless messages.

Rachabathuni et al. U.S. Patent 6,628,938 discloses a wireless system, a method of selecting an application while receiving application specific messages and user location method using user location awareness.

Zellner et al. U.S. Patent 6,675,017 discloses a location blocking service for wireless networks.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brandon J Miller whose telephone number is 703-305-4222. The examiner can normally be reached on Mon.-Fri. 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on 703-308-5318. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

April 7, 2004



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